

REMARKS

This Response is submitted in reply to the Office Action dated June 25, 2009. Claims 1 to 2, 6 to 8, 10 to 14, 16 to 20, 22 to 23, 25, 32, 37, 42, 48 and 55 have been amended. No new matter has been added by these amendments. A Terminal Disclaimer is submitted herewith.

Applicant submits that a plurality of the non-patent literature publication entries identified in the Information Disclosure Statement filed on 4/19/2004 have been lined through. Applicant submits that it appears that these lined through non-patent literature publication entries are lacking pagination. Accordingly, submitted herewith is a corrected PTO form 1449 including a listing of the non-patent literature publications submitted on 4/19/2004 which were lined through. The non-patent literature publications listed in this corrected PTO form 1449 each include their respective number of pages. Copies of these non-patent literature publications were submitted on 4/19/2004 and thus are not submitted herewith. Applicant respectfully requests that the Examiner contact the undersigned if another copy of these references is needed. Applicant additionally respectfully requests the Examiner to please consider these references in association with the present patent application.

Please charge deposit account number 02-1818 to cover the cost of any fees due in connection with these Information Disclosure Statement corrections, the Terminal Disclaimer, and this Response.

The Office Action rejected Claims 25 to 29, 32 to 34, 37 to 39, 42 to 45, 48 to 52 and 55 to 57 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Specifically, page 3 of the Office Action stated that "[a]s per decision of *Bilski*, any invention having a claimed method that is neither tied to another statutory category nor transforms underlying subject matter to another state or thing is non-statutory." Applicant respectfully disagrees. Nonetheless, to advance prosecution, Applicant has amended Claims 25, 32, 37, 42, 48 and 55 to each include at least one processor and at least one display device. Accordingly, Applicant respectfully requests that the rejection of Claims 25 to 29, 32 to 34, 37 to 39, 42 to 45, 48 to 52 and 55 to 57 under 35 U.S.C. § 101 be reconsidered and withdrawn.

The Office Action rejected Claims 1 to 59 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 33 of U.S. Patent No. 6,719,632. For purposes of advancing the prosecution of this application, Applicant has elected to overcome such rejection through the enclosed Terminal Disclaimer. Such election shall not be deemed an admission as to the propriety or accuracy of the Office Action's conclusions or rejections.

The Office Action rejected Claims 8 to 10, 22 to 24, 32 to 36 and 55 to 59 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,855,514 to Kamille ("Kamille"). Applicant respectfully disagrees for at least the following reasons.

The Abstract of Kamille discloses:

[a] probability game having multiple game pieces with areas which are covered with a removable concealer and contain a number of void and/or win areas. The game is controlled by player-made choices with respect to selecting areas to uncover on the game pieces that are potential winners.

Column 10, lines 45 to 64 of Kamille disclose:

[F]IG. 7C is an alternative embodiment of an uncovered game piece for a Field of Stars game with a teaser prize in order to add player interest. Referring to FIG. 7C, the game piece includes a number of starting arrows to indicate to the player where to start to play. Note that the game piece may have only one such start arrow. Regardless of which arrow is chosen by the player, the player is guaranteed to encounter a win area early during the playing of the game piece. This is a teaser prize that is small in comparison to the prize of the game piece and/or a potential large prize; however, the presence of the teaser prize raises the price of loss to the player as a winning amount is already being risked by continuing to play. Thus, risk is being added to the game while not costing the sponsor much at all. After uncovering the teaser prize, directionals direct the player's choices of the next play areas to uncover, if desired.

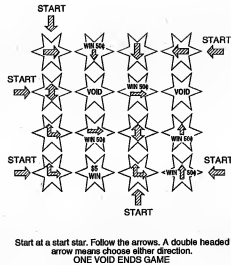


FIG. 7C





Column 3, lines 59 to 67 and Column 4, lines 1 to 3 of Kamille disclose:

[a] probability game is described. The probability game of the present invention has multiple game pieces. Each game piece has areas which are covered with a removable concealer that conceals the areas. Each game piece also contains a number of areas which are either void or win areas. In this way, the group of game pieces include guaranteed winners, guaranteed losers, and potential winners and in which the outcome is controlled by the laws of probability through player-made choices with respect to selecting areas to uncover on the game pieces that present winning indicia. At least one of the game pieces has an indication that allows winning in spite of the presence of uncovered void areas.

Amended independent Claim 8 is directed to a gaming device including, amongst other elements, at least one memory device which stores a plurality of instructions, which when executed by the at least one processor cause the at least one processor to operate with the at least one display device and the at least one input device to control a play of a game after a placement of a wager by: (a) causing a selection of one of a plurality of position moves; (b) after causing the selection of the position move, determining one of a plurality of positions based on the selected position move, a plurality of awards are associated with a plurality of the positions; (c) after determining one of the positions, associating a terminator with at least one of the position moves; (d)

forming an offer based on any award associated with the determined position; (e) enabling a player to accept or reject the offer; (f) providing the offer to the player if the player accepts the offer; and (g) if the player rejects the offer, repeating steps (a) to (f) until the player accepts an offer or the terminator is associated with the selected position move.

Applicant submits that the Office Action appears to interpret:

- (i) the play areas of Kamille as the positions of the gaming device of independent Claim 8;
- (ii) the directional arrows of the play areas of Kamille (e.g., the down directional arrow of the  play area) as the position moves of the gaming device of independent Claim 8;
- (iii) the awards associated with the play areas of Kamille (e.g., the 50 cent award associated with the  play area) as the awards of the gaming device of independent Claim 8;
- (iv) the  play area of Kamille as the terminator of the gaming device of independent Claim 8;
- (v) a directional arrow of a play area of Kamille pointing to or otherwise directing toward a  play area as associating the terminator with at least one of the position moves of the gaming device of independent Claim 8.

Under this interpretation, Applicant submits that Kamille does not anticipate or render obvious at least one memory device which stores a plurality of instructions, which when executed by the at least one processor cause the at least one processor to operate with the at least one display device and the at least one input device to control a play of a game after a placement of a wager by, after determining one of the positions, associating a terminator with at least one of the position moves.

Applicant submits that, in Kamille, each play area and the location of each play area on the game piece is determined before the player purchases the game piece (i.e., before the placement of a wager). For example, column 9, lines 38 to 42 disclose that:

[t]he probability game of the present invention provides a known number of winners and losers which will yield a known and predictable total prize liability based on laws of probability. Unlike a banking game, the preprinted game piece can only yield what is printed on the surface. (emphasis added)

Applicant submits that, under the Office Action's interpretation, because each game piece in Kamille is preprinted (i.e., each play area on the game piece is in a predetermined position relative to another one of the play areas before the game piece is purchased), the directional arrow which points to a ☆ play area (i.e., the interpreted position move associated with a terminator) is associated with that ☆ play area before the player purchases the game piece. In other words, under the Office Action's interpretation, the down directional arrow of the ☆ play area is associated with the ☆ play area before a player purchases a game piece (i.e., before a placement of a wager) and thus before the selection of any play areas of Kamille. On the other hand, the gaming device of amended independent Claim 8 includes, amongst other elements, at least one memory device which stores a plurality of instructions, which when executed by the at least one processor cause the at least one processor to operate with the at least one display device and the at least one input device to control a play of a game after a placement of a wager by, after determining one of the positions, associating a terminator with at least one of the position moves.

For at least these reasons, Applicant respectfully submits that amended independent Claim 8 is patentably distinguished over Kamille and is in condition for allowance.

Claims 9 and 10 each depend directly or indirectly from amended independent Claim 8 and are also allowable for the reasons given with respect to amended independent Claim 8 and because of the additional features recited in these claims.

Amended independent Claims 22, 32 and 55 each include certain similar elements to amended independent Claim 8. For reasons similar to those discussed

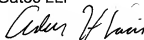
above with respect to amended independent Claim 8, amended independent Claims 22, 32 and 55 (and dependent Claims 23 to 24, 33 to 36, 56 to 59) are each patentably distinguished over Kamille and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

K&L Gates LLP

BY



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